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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/389,318	09/03/1999	OSAMU SUZUKI	001560-372	5287
21839	7590	02/11/2003		
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER	
			MARX, IRENE	
			ART UNIT	PAPER NUMBER
			1651	
			DATE MAILED: 02/11/2003	20

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/389,318

Applicant(s)

Suzuki et al.

Examiner

Irene Marx

Art Unit

1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Dec 30, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1, 3-8, 10-15, and 17-33 is/are pending in the application.
- 4a) Of the above, claim(s) 8, 10-15, and 17-30 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1, 3-7, and 31-33 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 19
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

The amendment filed 12/16/02 is acknowledged. Claim 1, 3-7, and 31-33 are being examined on the merits. Claims 8, 10-15, and 17-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

This application contains claims 8, 10-15, and 17-30 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The Information Disclosure Statement has been entered and considered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6-7 and 33-34 are/remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kyle for the reasons as stated in the last Office action and the further reasons below.

Applicant's arguments and "Experiment Report" have been fully considered but they are not deemed to be persuasive.

The "Experiment Report" is not probative of unexpected results. To be of probative value, any objective evidence must be factually supported by an appropriate affidavit or declaration which includes evidence of unexpected results, for example. See, for example, In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of

tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991). The Report is not in declaration form, is not signed, does not identify the person doing the experiments, does not have the penalty paragraph, etc.

Applicants argue that Kyle does not render obvious the invention as claimed because the "Experimental Report" shows the two specific strains of *M. alpina* grown in media containing 4% glucose produce a better yield of arachidonic acid. However, in the data presented there is no clear nexus between culturing any *M. alpina* having resistance to a carbon source of high concentration, in a certain medium, and the production of 7 g/l of arachidonic acid. The data demonstrates that one strain of *M. alpina* and strain *Mortierella SAM 2197* have this capacity. The present written disclosure fails to demonstrate that strain *Mortierella SAM 2197* belongs to *M. alpina* as alleged in the report.

The showing is insufficient to demonstrate that any *M. alpina* resistant to 4% glucose will similarly produce 7 g/l arachidonic acid based on the proffer, since only one strain from this species is shown, and since the Kyle strain of this species appears to be "resistant" to 8% and 10% glucose, which is deemed a "high concentration" of carbon. There is no clear correlation between the "resistance to a carbon source of high concentration" and the productivity claimed for strains other than those demonstrated.

The scope of the showing must be commensurate with the scope of claims to consider evidence probative of unexpected results, for example. *In re Dill*, 202 USPQ 805 (CCPA, 1979), *In re Lindner* 173 USPQ 356 (CCPA 1972), *In re Hyson*, 172 USPQ 399 (CCPA 1972), *In re Boesch*, 205 USPQ 215, (CCPA 1980), *In re Grasselli*, 218 USPQ 769 (Fed. Cir. 1983), *In re Clemens*, 206 USPQ 289 (CCPA 1980). It should be clear that the probative value of the data is not commensurate in scope with the degree of protection sought by the claim.

Claim 34 is allowable, since it is directed to a process of production of arachidonic acid by strain *Mortierella SAM 2197* in amounts of at least 7 g/l in 5-10 days, which is neither taught

nor fairly suggested by the prior art. One of ordinary skill in the art would not be motivated to use this particular strain in a process of production of arachidonic acid as claimed.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is before final (703) 872-9306 and after final, (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service whose telephone number is (703) 308-0198 or the receptionist whose telephone number is (703) 308-1235.



Irene Marx  
Primary Examiner  
Art Unit 1651